

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNARD RAYMOND PIERRE

Appeal No. 2000-1028
Application No. 08/950,522

ON BRIEF

Before PAK, WARREN, and WALTZ, ***Administrative Patent Judges.***

WALTZ, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 18 through 27, which are the only claims remaining in this application (see the Brief, page 2). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a method of coating sheets by sequentially conveying a plurality of sheets along a sheet path with the machine direction of the

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sheets consistently oriented parallel to the direction of movement of the sheets, with subsequent coating of both major surfaces of the sheets, drying the coatings on the sheets, overlapping the dry coated sheets, and then applying a further coating onto one of the major surfaces of the overlapped sheets (Brief, page 3). A copy of illustrative independent claim 18 is attached as an Appendix to this decision.

The examiner relies upon the following references as evidence of obviousness:

Swanson et al. (Swanson)	3,723,174	Mar. 27, 1973
Thierstein	4,526,362	Jul. 02, 1985
Greiner et al. (Greiner)	4,664,949	May 12, 1987
Ritter	5,487,780	Jan. 30, 1996

Calkin, *Modern Pulp and Paper Making*, 3rd ed., pp. 361-62, Reinhold Publishing Corp., New York, 1957.

Claims 18-23 and 25-27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ritter in view of Greiner and Swanson or Calkin (Answer, page 4). Claim 24 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the references as applied above further in view of Thierstein (Answer, page 6).¹ We reverse both of the examiner's rejections for reasons which follow.

¹Contrary to appellant's Brief (page 3), and as noted on page 2 of the Answer, there is no rejection on appeal based on the second paragraph of 35 U.S.C. § 112.

OPINION

The examiner finds that Ritter teaches a method of applying a coating to overlapped sheets, where the overlapped sheets are conveyed through two coating rollers that simultaneously apply a water-based coating to both surfaces of the sheets at the same point on the surface (Answer, page 4). The examiner further finds that Ritter teaches that both surfaces of the sheets are dried simultaneously and then a coating of adhesive is applied to one surface of the sheet (*id.*). The examiner applies Greiner as evidence that it was conventional in this art "to apply different coatings to both sides of individual sheets simultaneously" (Answer, page 5). The examiner further finds that neither Ritter nor Greiner teach consistently feeding the sheets in the machine direction (Answer, page 6). Thus the examiner applies either Calkin or Swanson as evidence that feeding and coating paper sheets in the machine direction was well known and conventional in the art (*id.*).

The examiner recognizes that Ritter fails to teach that the coating material is applied to the sheets before the overlapping step (Answer, page 5). However, it is the "examiner's position" that one of ordinary skill in the art "would perform these two steps of the process in a sequence consistent with the desired

product of the process at hand." *Id.* We determine that the examiner has failed to support this "position" by any convincing reasoning or factual evidence.

Ritter teaches providing a plurality of sheets and then overlapping these sheets *before* any coating or drying operations (e.g., see col. 1, l. 63-col. 2, l. 5; col. 2, ll. 38-46). The overlapping of the sheets throughout the first four stations is maintained by "strict control" of the speeds of the drive mechanisms (col. 4, ll. 15-17 and 24-27). The overlapping of the sheets tends to prevent intermingling of the primer and backsize materials (col. 6, ll. 15-18), as well as reduce the tendency of the sheets to curl or wave (col. 8, ll. 48-53). The only operation where the sheets are not overlapped occurs at the sheet inserting station **5** (col. 8, ll. 9-20).

The subject matter on appeal requires an overlapping step between the drying and second coating steps (see claim 18 on appeal). The examiner has not met the initial burden of proof in establishing a *prima facie* case of obviousness by showing any convincing suggestion, motivation, or reasoning why one of ordinary skill in this art would have an overlapping step between the drying and second coating steps when Ritter fails to teach or suggest this sequence. The "examiner's position" that one of

ordinary skill in the art "would perform these two steps of the process in a sequence consistent with the desired product of the process at hand" (Answer, page 5) is a conclusory statement that the examiner has not supported by any factual basis or convincing reasoning. See *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) ("The examiner's conclusory statements ... do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority."). The examiner has not explained why another product would have been "desired." Additionally, the examiner only addresses the interchange of the overlapping and coating steps (Answer, page 5) while Ritter teaches an overlapping step before the first coating step, the *drying* step, and the second coating step. Therefore, the examiner has failed to address or explain the motivation for moving all of these steps taught by Ritter to achieve the order or sequence of steps recited in the claims on appeal.

For the foregoing reasons, we determine that the examiner has failed to establish a *prima facie* case of obviousness in view of Ritter. As discussed above, the secondary references to Greiner, Calkin and Swanson do not remedy the deficiency noted

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above in Ritter. Similarly, Thierstein was applied against claim 24 by the examiner for the teaching of a particular overlapping sequence (Answer, pages 6-7) and thus also does not remedy the deficiency noted above in Ritter. Accordingly, we reverse both of the examiner's rejections under section 103(a).

The decision of the examiner is reversed.

Other Issues

Upon the return of this application to the jurisdiction of the examiner, the examiner and appellant should consider the

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patentability of the claims in view of double patenting over the
claimed subject matter of U.S. Patent No. 5,916,630 (i.e., S.N.
08/957,408, see the Brief, page 2).

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
Thomas A. Waltz)	
Administrative Patent Judge)	

TAW/dal

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